

Application Serial No.: 10/518,395
Attorney Docket No.: 08997.0005-00

AMENDMENTS TO THE DRAWINGS:

Subject to the Examiner's approval, please substitute original FIGs. 3 and 8 with the attached replacement FIGs. 3 and 8.

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REMARKS

Applicants respectfully request reconsideration of the present application in view of the following remarks. Prior to entry of this response, claims 30-58 were pending in the application, of which claims 30 and 42 are independent. In the Office Action dated July 6, 2006, the Examiner objected to Applicant's claim to priority, the declaration, and Figures 3 and 8. Also, claims 30-33, 36-37, 39-44, 46, 49, 54-55, and 58 were rejected under 35 U.S.C. §102, and claims 34-35, 38, 45, 47-48, 50-53, and 56 were rejected under 35 U.S.C. § 103(a). Following this response, claims 30-58 remain pending and new independent claim 59 is presented. Claims 34-38 and 44-48 have each been rewritten in independent form. Applicant hereby addresses the Examiner's objections and rejections in turn.

I. Objection to Applicant's Claim of Priority

In the July 6th Office Action, the Examiner states that the present application "claim[s] the benefit of prior-filed non-provisional application No. PCT/EP02/07077 under 35 U.S.C. 120, 121, or 365(c)." (First Office Action Page 2). In addition, the Examiner states that "[s]ince the applications are not copending, the benefit claim to the prior-filed nonprovisional application is improper." *Id.*

However, Applicant does not claim the benefit of PCT/EP02/07077. As noted in the filing receipt, the present application is an entry into the national stage of International Application No. PCT/EP2002/007077 under 35 U.S.C. §371. Therefore, the filing date of the present application is the same as the PCT International filing date of June 26, 2002.

An international application designating the U.S. has two stages (international and national) with the filing date being the same in both

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stages. Often the date of entry into the national stage is confused with the filing date. It should be borne in mind that the filing date of the international stage application is also the filing date for the national stage application.

MPEP §1893.03(b) (emphasis added); see also 35 U.S.C. §363.

In a July 26, 2006 telephone conversation with Applicant's counsel, the Examiner stated that he made the priority objection because the Applicant had not entered the national stage within 18 months from the date the PCT application was filed. However, the relevant time limitation for entering the national stage is 30 months, not 18 months.

To begin entry into the national stage, applicant is required to comply with 37 CFR 1.495(b) within 30 months from the priority date. Thus, applicant must pay the basic national fee on or before 30 months from the priority date and be sure that a copy of the international application has been received by the U.S. Designated or Elected Office prior to expiration of 30 months from the priority date.

MPEP §1893.01(a)(1); see also 35 U.S.C. §371(b); PCT Article 22(1). The "priority date" for purposes of 37 CFR §1.495(b) for this application is the date on which the PCT application was filed, June 26, 2002. See PCT Article 2(xi)(c). Here, the PTO received Applicant's basic national fee and a copy of the PCT application on December 17, 2004, which was "within 30 months from the priority date." Therefore, Applicant complied with 37 CFR §1.495(b), and Applicant requests that the Examiner withdraw the priority objection.

II. Objection to the Oath/Declaration

In the July 6th Office Action, the Examiner states that the oath/declaration is defective because "the US application in which the present application claims priority to has not been provided in the oath/declaration." First Office Action at 4. As discussed above, however, the present application does not claim the benefit of PCT/EP2002/007077. Nor does the present application claim the benefit of any other

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prior-filed application. Instead, the oath/declaration (filed January 9, 2005) indicates that it is directed to the specification of PCT/EP2002/007077. Therefore, Applicant requests that the Examiner withdraw his objection to the oath/declaration of the present application.

III. Objection to the Drawings

The Examiner objected to Figures 3 and 8 as not complying with MPEP §608.02. Applicant has corrected Figures 3 and 8 to comply with MPEP §608.02. In addition to the corrected drawing figures, Applicant submits a marked-up copy of each Replacement Sheet in accordance with 37 CFR §1.121(d)(1).

IV. Specification

The Examiner objects to the specification of the present application, stating that the abstract improperly contains the term "comprising." However, the abstract of the present application does not contain the term "comprising." Applicant's preliminary amendment (dated December 17, 2004) amended the specification to "[r]eplace the abstract originally provided on the cover sheet of the PCT application with the new abstract as follows...." Preliminary Amendment at 8. Applicant's new abstract does not contain the word "comprising." Therefore, Applicant respectfully requests that the Examiner withdraw his objection to the specification of the present application.

V. Amendments to the Claims

Claim 30 and 34-38 have been amended to recite, among other things, "placing a volume change compensation member into said cavity to maintain a compensating volume in said cavity in an area of non-critical electrical field as said insulating material is introduced into said cavity." Claims 42 and 44-48 have been amended to recite, for

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example, "said volume change compensation member being located in said cavity in an area of non-critical electrical field." These amendments are supported in the specification at least at pages 9, 16, 24, and 25, as well as in Figures 2-4 and 8. Accordingly, Applicant submits that no new matter is introduced by these amendments.

In addition to the amendments to claims 34-38 and 44-48 discussed above, claims 34-38 have been rewritten in independent form to include the limitations of claim 30 and claims 44-48 have been rewritten in independent form to include the limitations of claim 42. Because these amendments do not present any features that were not previously presented in the claims, Applicants assert that they do not introduce new matter.

VI. 35 U.S.C. §102(b) Rejections

The Examiner rejected claims 30-33, 36-37, 39-44, 46, 49, 54-55, and 58 under 35 U.S.C. §102(b) as being anticipated by European Patent No. EP 1170846 ("Goehlich"). First Office Action at 6. However, Applicant respectfully asserts that Goehlich is not §102(b) prior art against Applicant's application. Goehlich is a foreign patent which was published on January 9, 2002, and granted on October 26, 2005. As discussed above, Applicant's filing date is June 26, 2002. Because Goehlich was neither granted nor published more than one year before Applicant's filing date, it cannot be cited against Applicant as §102(b) prior art. Applicant requests that the Examiner withdraw his §102(b) rejections, which were based solely on Goehlich.

In any case, Goehlich does not teach "placing a volume change compensation member into said cavity to maintain a compensating volume in said cavity in an area of non-critical electrical field as said insulating material is introduced into said cavity," as

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recited in independent claim 30. The Examiner asserts that the empty space (termed "air" by the Examiner) inside the upper cavity 1 of Goehlich is a volume change compensation member. Empty space, however, is not a "member." Applicant's specification uses the term "member" consistently with its ordinary meaning. The dictionary definition of "member" most applicable in the context of Applicant's invention is "a structural unit." American Heritage College Dictionary, 3d Ed. at 849 [Attached hereto as Exhibit 1]. The empty space inside the upper cavity 1 of Goehlich is not a structural unit placed inside the cavity to maintain a compensating volume in said cavity in an area of non-critical electrical field as said insulating material is introduced into said cavity, as recited in claim 30. Indeed, the "air" inside the cavity of Goehlich would do nothing to prevent insulating liquid from entering that space when introduced into to the cavity. Accordingly, Goehlich does not teach each limitation of claim 30, and therefore does not anticipate claim 30, or claims 32-33 and 39-41, which depend from claim 1 and include each of its limitations.

Claim 42 recites "a volume change compensation member having a predetermined volume to ensure the accommodation of said volume expansions, said volume change compensation member being located in said cavity in an area of non-critical electrical field." As discussed above, Goehlich does not teach this limitation. The empty space shown in upper cavity 1 of Goehlich is not a volume change compensation member because it is not a structural unit of the termination. Accordingly, because Goehlich does not teach each element of claim 42, it does not anticipate claim 42, or claims 43, 49, 54-55 or 58.

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Although claims 36-37, 44, and 46 have been rewritten in independent form, they also recite a "volume change compensation member." For the same reasons discussed above, the empty space in the cavity of Goehlich is not a volume change compensation member. In further regard to claims 36 and 46, each of those claims recites that the volume change compensation member is a hollow body. The "hollow void" referred to by the Examiner cannot meet the recitation of claims 36 and 46 because it is simply empty space inside the cavity. The cavity is separately recited in Applicant's claims. The empty space alone is not a member comprising a hollow body. For these reasons, Goehlich does not anticipate claims 36-37, 44, or 46.

VII. 35 U.S.C. §103 Rejections

The Examiner rejected claims 34-35, 38, 47-48, 50-53, and 56 under 35 U.S.C. §103(a) as being unpatentable over the combination of Goehlich and U.S. Patent No. 6,235,992 ("Abisso"). To establish a *prima facie* case of obviousness of these claims, there must be some suggestion or motivation to combine reference teachings. MPEP §2143. Prior-art references must be considered as a whole, including portions that would lead away from the claimed invention. MPEP §2141.02(VI); *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.3d 1540 (Fed. Cir. 1983).

Here, Abisso teaches away from Applicant's claimed invention, and therefore cannot properly be combined with Goehlich to establish a *prima facie* case of obviousness. Each of claims 34-35 and 38 recites, among other things, "creating a compensating volume in said cavity in an area of non-critical electrical field by placing a volume change compensation member into said cavity, said volume change compensation member having a predetermined volume to accommodate volume

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expansions of said insulating material within said cavity." Similarly, independent claim 42 recites, for example, "a volume change compensation member having a predetermined volume to ensure the accommodation of said volume expansions, said volume change compensation member being located in said cavity in an area of non-critical electrical field." In describing the Background of the Invention, Abisso describes "compensating volumes" used in prior art devices as a "drawback" (Col 1, lines 28-39). To overcome this "drawback," Abisso sought to "realise an electrical device...having improved compressibility in order to be applicable within a wide functioning temperature range without requiring compensating volumes." Abisso at 2:25-30 (emphasis added). Indeed, the July 6th Office Action noted that Abisso does not use compensating volumes. First Office Action at 11.

Because Abisso teaches away from the use of compensating volumes, there is no motivation to combine Goehlich and Abisso. See MPEP §2145(X)(D)(2) ("It is improper to combine references where the references teach away from their combination."). Therefore, the Examiner has not established a prima facie case of obviousness, and Applicant respectfully requests that the Examiner withdraw the rejection of the claims under 35 U.S.C. § 103.

VIII. New Claim

Applicant presents new claim 59. Support for this claim is in the specification at least at pages 9-11. Accordingly, Applicant submits that no new matter is presented in this new claim. Applicant further submits that the Examiner's rejection of the claims under 35 U.S.C. §102 and §103 are not applicable to claim 59, as neither Goehlich nor Abisso teaches or suggests claim 59's recitation of

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placing a volume change compensation member into said cavity, said volume change compensation member having a predetermined volume to accommodate volume expansions of said insulating material within said cavity; and removing said volume change compensation member after filling said insulation material into said cavity.

Accordingly, Applicants respectfully request the timely allowance of new claim 59.

IX. Conclusion

In view of the foregoing remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims. The preceding arguments are based only on the arguments in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The claims may include other elements that are not shown, taught, or suggested by the cited art not specifically discussed herein. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

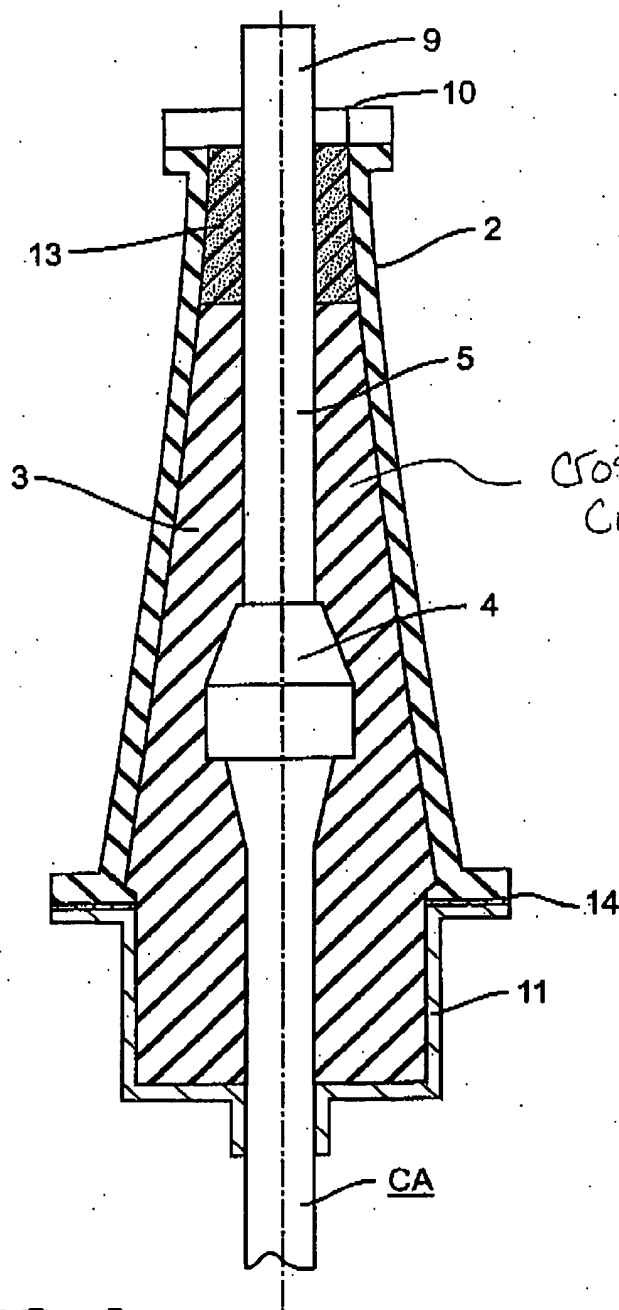
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 6, 2006

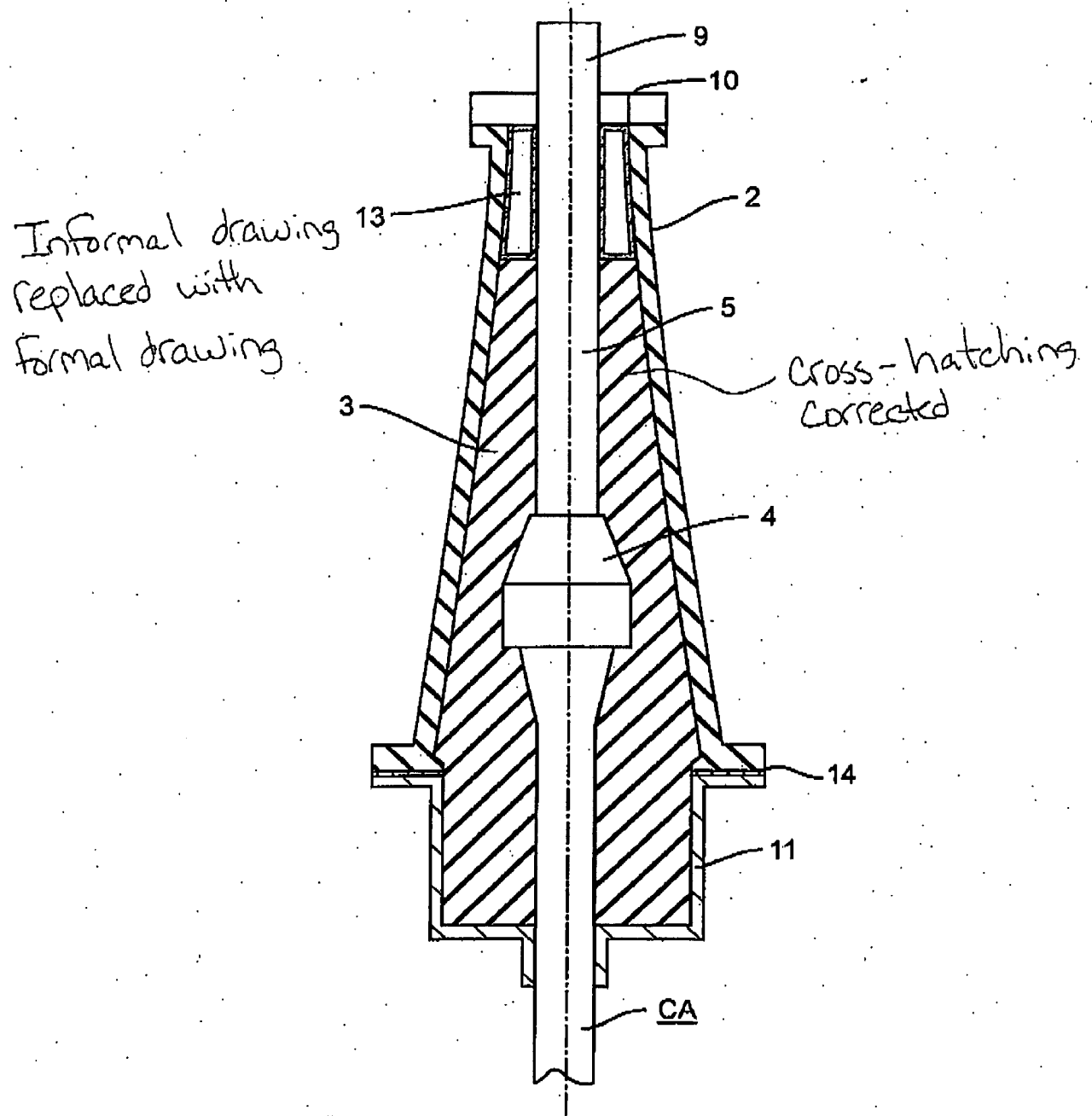
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Annotated Sheet

**FIG. 3**

Annotated Sheet

**FIG. 8**